

S/N 09/767,819



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Robert M. Zeidman

Examiner: Schnurr, John R.

Serial No.: 09/767,819

Group Art Unit: 2623

Filed: January 22, 2001

Docket No.: Zeid-02

Title: Method For Advertisers to Sponsor Broadcasts Without Commercials

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

The Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this Request, which is being filed with a Notice of Appeal for the reasons stated below. As a courtesy, the currently pending claims are provided with this Request. The Request itself complies with the requirement of five (5) or less total pages, which provide a succinct, concise and focused set of arguments for which the review is being requested.

§103 Rejection of the Claims

Claims 1-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the 1997 Broadcast of "Schindler's List" on NBC in view of Matheny et al. (U.S. Patent No. 6,766,524), hereinafter "Matheny"; and further in view of Blackketter et al. (U.S. Patent No. 7,103,904), hereinafter "Blackketter"; and further in view of Williams et al. (U.S. Patent No. 6,075,971), hereinafter "Williams". However, because a *prima facie* case of obviousness has not been properly established by the Office, the rejection of these claims is respectfully traversed.

As noted in previous responses, the Office asserts that it would be obvious to combine Schindler's List, Matheny, Blackketter, and Williams because of the reasons summarized below for each reference.

"[Schindler's List] provides evidence that it is known in the art of television broadcasting to 'allow content to be broadcast without commercial interruption' yet still be sponsored by companies. However, the evidence of the particular species of 'broadcast programming' is silent with respect [to] further providing incentives to viewers to watch." (Feb. 4, 2009 Final Office

Action, pg. 2). Further, Schindler's List is silent on providing incentives without prompting the user for feedback.

"Matheny provides specific incentives or rewards to the viewer based on said viewing record including information indicative of one or more sponsors of the broadcast. ... It is unclear from Matheny et al. whether or not the 'embedded information includes information indicative of one or more sponsors of the broadcast' such as a sponsor name. ... The system further 'collect[s] viewer information including a user identifier and information indicative of an amount of the broadcast viewed by the viewer, specific incentives and links to the specific incentives being associated with the amount of the broadcast viewed by the viewer' (Figures 2-4 col. 3 line 46 to col. 4 line 48)." (Feb. 4, 2009 Final Office Action, pg. 3). Further, Matheny is also silent on providing incentives without prompting the user for feedback.

"Blackketter et al., in conjunction with its usage of advertising templates teaches that it is known in the art for 'embedded information' such as triggers to 'include information indicative of one or more sponsors of the broadcast' such as the sponsor name. ... However, the above combination does not specifically teach collecting the viewer information without prompting the user for feedback." (Feb. 4, 2009 Final Office Action, pg. 3). Further, Blackketter is silent on providing specific incentives and links to the specific incentives being associated with the amount of the broadcast viewed by the viewer.

"Williams et al. discloses providing coupons to a network device without prompting the user for feedback. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combination of Matheny et al. and Blackketter et al. using the teachings of Williams et al. for the purpose of gathering user data without interruption." (Feb. 4, 2009 Final Office Action, pg. 3). However, Williams is silent on providing specific incentives and links to the specific incentives being associated with the amount of the broadcast viewed by the viewer. Williams is also silent on providing specific incentives including information indicative of one or more sponsors of the broadcast.

The Office has the initial burden to establish a proper *prima facie* case of obviousness. To accomplish this task, the Office must demonstrate that: (a) every feature of the claimed

embodiment is present in the proposed combination, and (b) there is proper motivation to make such a combination. This second factor is lacking in the current rejections set forth by the Office.

When combining the features of two references makes them inoperative, or the references teach away from such a combination, then there is no proper motivation to combine, and it is irrelevant as to whether the references teach all of the claimed features. That is, even when every claimed element is present in the proposed combination, there are situations when the combination can not be properly made. This is precisely what occurs with the combination of Schindler's List, Matheny, Blackketter, and Williams proposed by the Office.

As set forth in controlling precedent, "... the test for obviousness under §103 must take into consideration the invention as a whole; that is, one must consider the particular problem solved by the combination of elements that define the invention. See *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir.1985). The Examiner must, as one of the inquiries pertinent to any obviousness inquiry under 35 U.S.C. §103, recognize and consider not only the similarities but also the critical differences between the claimed invention and the prior art. See *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990), reh'g denied, 1990 U.S. App. LEXIS 19971 (Fed. Cir.1990). **The fact that a reference teaches away from a claimed invention is highly probative that the reference would not have rendered the claimed invention obvious to one of ordinary skill in the art.** *Stranco Inc. v. Atlantes Chemical Systems, Inc.*, 15 USPQ2d 1704, 1713 (Tex. 1990). When the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be non-obvious. *Id.* p. 4 citing *United States v. Adams*, 383 U.S. 39, 51-51 (1966). Additionally, critical differences in the prior art must be recognized (when attempting to combine references). *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990), reh'g denied, 1990 U.S. App. LEXIS 19971 (Fed. Cir.1990)." (emphasis added). Moreover, a patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art. *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727 (2007).

As admitted in the current and prior Office Actions, the combination of Schindler's List, Matheny, and Blackketter does not teach collecting viewer information without prompting the

user for feedback. In fact, Matheny teaches a system and method that requires viewer feedback as part of the reward validation and fulfillment process; yet, Matheny was offered by the Office as the primary reference allegedly teaching many of the pending claim elements, including specific incentives or rewards based on sponsors of the broadcast. As described in Matheny, “viewers must provide some feedback to indicate that they watched the commercial before they are entitled to a reward.” See Matheny, col. 3, lines 14-30, emphasis added. As such, Matheny teaches a system implemented to require such prompted viewer feedback from the viewer as part of viewer participation in an interactive reward program. This teaching of required viewer feedback in Matheny is directly opposite of and inconsistent with the approach presently claimed, wherein the pending claims specifically recite that, “viewer information is not collected in response to prompted viewer feedback”.

Matheny was also offered by the Office as the primary reference allegedly teaching ‘collecting viewer information indicative of an amount of the broadcast viewed by the viewer, specific incentives and links to the specific incentives being associated with the amount of the broadcast viewed by the viewer’. However, the portion of Matheny cited in the current and prior Office Actions as support for this element teaches, “if a viewer answers question 269, then set-top box 245 notes the identity of the program in which the question appeared, the time the question was posed, a value expressing how much of the program was viewed.” See Matheny, Figures 2-4, col. 3 line 46 to col. 4 line 48, emphasis added. Again, this teaching of collecting viewer information indicative of an amount of the broadcast viewed by the viewer in Matheny is based on user feedback and directly opposite of and inconsistent with the approach presently claimed, wherein the pending claims specifically recite that, “viewer information is not collected in response to prompted viewer feedback.” Schindler’s List, Blackketter, and Williams do not teach a system for collecting viewer information indicative of an amount of the broadcast viewed by the viewer; thus, only the teachings in Matheny can support a rejection of this claim element. However, Matheny only teaches a prompted viewer feedback implementation of this element.

In summary, the combination of Schindler’s List, Matheny, and Blackketter teaches directly away from a system that collects viewer information without prompting the user for feedback. Williams is silent on providing specific incentives and links to the specific incentives

associated with the amount of the broadcast viewed by the viewer and including information indicative of one or more sponsors of the broadcast. Therefore, the Office has failed to establish a proper *prima facie* case of obviousness by failing to demonstrate a proper motivation to make the alleged combination. Rather, the obviousness rejection has improperly cobbled together elements from four inconsistent references that teach directly away from the presently claimed embodiments. Thus, one of ordinary skill would not find it obvious to combine these references, as suggested by the Office, because an inoperative system would result. Therefore, reconsideration and withdrawal of the rejections under 35 USC § 103(a) in view of Schindler's List, Matheny, Blackketter and Williams is respectfully requested.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney, Jim H. Salter, at 408-406-4855 to facilitate prosecution of this application.

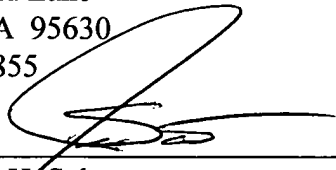
Respectfully submitted,

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Date 3/31/09

By 
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 31 day of March, 2009.

Name Jim H. Salter

Name

Signature 

Signature

3/31/09

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CURRENT CLAIMS

1. (Previously Presented) A method for allowing content to be broadcast without commercial interruption, yet letting a sponsor of the broadcast offer incentives to viewers to watch the broadcast, the method comprising:

receiving a broadcast with embedded information about the broadcast, said embedded information being provided to allow construction of a viewing record of the broadcast, the embedded information including information indicative of one or more sponsors of the broadcast;

extracting and displaying content from said broadcast without commercial interruption to a viewer;

extracting said embedded information from said broadcast;

storing said embedded information;

collecting viewer information including a user identifier and information indicative of an amount of the broadcast viewed by the viewer, specific incentives and links to the specific incentives being associated with the amount of the broadcast viewed by the viewer, wherein the collected viewer information is not collected in response to prompted viewer feedback provided by the viewer as part of viewer participation in an interactive reward program;

sending said stored embedded information and viewer information to a remote computer to allow said remote computer to construct said viewing record; and

providing the specific incentives to the viewer based on said viewing record, the viewing record including viewer information obtained without prompted viewer feedback

provided by the viewer as part of viewer participation in an interactive reward program, the specific incentives including information indicative of one or more sponsors of the broadcast.

2. (Previously Presented) A method for allowing content to be broadcast without commercial interruption, yet letting a sponsor of the broadcast offer incentives to viewers to watch the broadcast, the method comprising:

receiving a broadcast with information about the broadcast embedded into the broadcast at regular time periods, said information including timestamps each identifying a time slice during which the broadcast is received, the embedded information including information indicative of one or more sponsors of the broadcast;

extracting and displaying content from said broadcast without commercial interruption to a viewer;

extracting said embedded information from said broadcast;

incrementing counters for counting time slices during which said broadcast is received;

storing said embedded information and said counter values;

collecting viewer information including a user identifier and information indicative of an amount of the broadcast viewed by the viewer, specific incentives and links to the specific incentives being associated with the amount of the broadcast viewed by the viewer, wherein the collected viewer information is not collected in response to prompted viewer feedback provided by the viewer as part of viewer participation in an interactive reward program;

sending said embedded information, said counter values and viewer information to a remote computer to allow a viewing time to be determined; and

providing the specific incentives to the viewer based on said embedded information and the viewer information obtained without prompted viewer feedback provided by the viewer as part of viewer participation in an interactive reward program, the specific incentives including information indicative of one or more sponsors of the broadcast.

3. (Previously Presented) A method for allowing content to be broadcast without commercial interruption, yet letting a sponsor of the broadcast offer incentives to viewers to watch the broadcast, the method comprising:

embedding information along with the broadcast content, said embedded information including information that allows viewer information to be determined, the viewer information including information indicative of an amount of the broadcast viewed by a remote viewer, specific incentives and links to the specific incentives being associated with the amount of the broadcast viewed by the remote viewer, the embedded information including information indicative of one or more sponsors of the broadcast; and

broadcasting said content with said embedded information to the remote viewer of the content without commercial interruption, the embedded information enabling a remote computer to retain the information indicative of one or more sponsors of the broadcast, and to determine the viewer information, the viewer information further including a user identifier and the information indicative of an amount of the broadcast viewed by the remote viewer, specific incentives being based in part on the amount of the broadcast viewed by the remote viewer, wherein the viewer information is not determined in response to prompted viewer feedback provided by the remote viewer as part of remote viewer participation in an interactive reward program.

4. (Previously Presented) The method of claim 3 further comprising:

obtaining the stored embedded information so as to determine said viewer information;
and

sending the links to the specific incentives to said remote viewer based on said viewer information, the viewer information being determined without prompted viewer feedback provided by the remote viewer as part of remote viewer participation in an interactive reward program.

5. (Previously Presented) A method for allowing content to be broadcast without commercial interruption, yet letting a sponsor of the broadcast offer incentives to viewers to watch the broadcast, the method comprising:

embedding information along with the broadcast content at regular time periods, wherein said embedded information, when collected over time, allows a viewing record of the broadcast to be determined, the embedded information including information indicative of one or more sponsors of the broadcast; and
broadcasting said content with said embedded information without commercial interruption to a remote viewer of the content, the embedded information enabling a remote computer to retain the viewing record, information indicative of one or more sponsors of the broadcast, and viewer information, the viewer information including a user identifier and information indicative of an amount of the broadcast viewed by the remote viewer, specific incentives and links to the specific incentives being associated with the amount of the broadcast viewed by the remote viewer, wherein the viewer information is not collected in response to prompted viewer feedback provided by the remote viewer as part of remote viewer participation in an interactive reward program.

6. (Previously Presented) The method of claim 5 further comprising:

providing collected embedded information about said broadcast at a predetermined time; from said collected embedded information, determining a number of time slices during which the broadcast is received by the remote viewer; and
sending links to the specific incentives to said remote viewer based on said time slices, the time slices being obtained without prompted viewer feedback provided by the remote viewer as part of remote viewer participation in an interactive reward program.

7. (Previously Presented) A method for allowing content to be broadcast without commercial interruption, yet letting a sponsor of the broadcast offer incentives to viewers to watch the broadcast, the method comprising:

receiving information representing a viewing record including information related to a viewer's viewing of a broadcast without commercial interruption, the viewing record including information indicative of one or more sponsors of the broadcast and viewer information including a user identifier and information indicative of an amount of the broadcast viewed by the viewer, specific incentives and links to the specific incentives being associated with the amount of the broadcast viewed by the viewer, wherein the viewer information is not collected in response to prompted viewer feedback provided by the remote viewer as part of viewer participation in an interactive reward program; and

sending the links to the specific incentives to the viewer based on said viewing record including information indicative of one or more sponsors of the broadcast, the viewing record including viewer information obtained without prompted viewer feedback provided by the viewer as part of viewer participation in an interactive reward program.

8. (Previously Presented) A method for allowing content to be broadcast without commercial interruption, yet letting a sponsor of the broadcast offer incentives to viewers to watch the broadcast, the method comprising:

receiving information about a remote viewer's viewing of a broadcast without commercial interruption, the received information including information indicative of one or more sponsors of the broadcast;

receiving counter values representing the number of time slices viewed by the remote viewer;

collecting viewer information including a user identifier and information indicative of an amount of the broadcast viewed by the viewer, specific incentives and links to the specific incentives being associated with the amount of the broadcast viewed by the viewer, wherein the collected viewer information is not collected in response to prompted viewer feedback provided by the remote viewer as part of remote viewer participation in an interactive reward program;

and

sending specific incentives to the remote viewer based on said information received, including information indicative of one or more sponsors of the broadcast, and said counter values received, said information received being obtained without prompted viewer feedback provided by the remote viewer as part of remote viewer participation in an interactive reward program.

9. (Previously Presented) A method for allowing content to be broadcast without commercial interruption, yet letting a sponsor of the broadcast offer incentives to viewers to watch the broadcast, the method comprising:

receiving information representing a viewing record including information related to a remote viewer's viewing of a broadcast without commercial interruption, the viewing record including information indicative of one or more sponsors of the broadcast, the viewing record further including information indicative of a user identifier and information indicative of an amount of the broadcast viewed by the remote viewer, specific incentives and links to the specific incentives being associated with the amount of the broadcast viewed by the remote viewer, wherein the information representing a viewing record is not collected in response to prompted viewer feedback provided by the remote viewer as part of remote viewer participation in an interactive reward program;

searching a database for information about sponsors of the content of said broadcast and the specific incentives offered by said sponsors;

creating a Web page containing links to sponsor incentive websites and to specific incentives based on said database information and said viewing record; and

sending said Web page to said remote viewer.

10. (Previously Presented) A method for allowing content to be broadcast without commercial interruption, yet letting a sponsor of the broadcast offer incentives to viewers to watch the broadcast, the method comprising:

receiving information representing a viewing record including information related to a remote viewer's viewing of a broadcast without commercial interruption, the viewing

record including information indicative of one or more sponsors of the broadcast and viewer information including information indicative of an amount of the broadcast viewed by the remote viewer, specific incentives and links to the specific incentives being associated with the amount of the broadcast viewed by the remote viewer, wherein the viewer information is not collected in response to prompted viewer feedback provided by the remote viewer as part of remote viewer participation in an interactive reward program;

receiving counter values representing the number of time slices during which the broadcast was viewed by said remote viewer;

searching a database for information about sponsors of the content and the specific incentives offered by said sponsors;

creating a Web page containing links to sponsor incentive websites and to specific incentives based on said database information, said viewing record, and said counter values; and

sending said Web page to said remote viewer.